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The amendment after final rejection submitted November 23, 1994 has been entered. Accordingly, claims 29-32 are pending. Claims 33-36 are cancelled.

The previously-indicated allowability of claims 31-32 is withdrawn in view of the following new ground of rejection. Accordingly, the finality of the previous rejection is also withdrawn.

Claims 29-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 and 5-7 of U.S. Patent No. 4,963,590. Although the conflicting claims are not identical, they are not patentably distinct from each other because compounds and compositions are obvious variants of one another since the composition may be merely a compound in water.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

The obviousness double patenting rejection is being made after careful inspection of the prosecution history of the parent application. The restriction requirement issued in Paper No. 4 of the parent case was a two-way restriction between (I) compositions and methods of use and (II) a process for preparing the products. However, the claims associated with group I were original claims 1-20

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and 26-31. Original claims 1-20 were directed to compounds. Applicant amended claim 1 prior to examination, making it a composition claim. However, claims 2-20 remained as compound claims. Thus, the election of group I also included the election of the compounds. Therefore, this record does not reflect a restriction requirement between compositions and compounds. Thus, applicant is not protected under the provisions of 35 USC 121, and a double patenting rejection is proper.

The specification is objected to because of the following informalities:
Page 16, example 8 of Table 1 contains a group for R^3 which has an unfilled valence. The group $C=O$ does not bond to anything. Correction is required.

Any inquiry concerning this communication should be directed to Examiner Haley at telephone number (703) 308-4548. The examiner may normally be reached Monday through Friday from 8:30 am until 6:00 pm.

jh
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Group 1200